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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,938	09/24/2003	Achintya K. Bhowmik	ITL1014US (P16650)	4613
21906 7590 07/22/2008 TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631				
EXAMINER DUPUIS, DEREK L.				
ART UNIT		PAPER NUMBER		
2883				
MAIL DATE		DELIVERY MODE		
07/22/2008		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ACHINTYA K. BHOWMIK

Appeal 2008-0487
Application 10/669,938
Technology Center 2800

Decided: July 21, 2008

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO, and
SCOTT R. BOALICK, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Final Rejection of claims 1-15. We have jurisdiction under 35 U.S.C. § 6(b).

Appellant's invention relates to the compensation of dispersion in an optical medium by tunably providing a dispersion of the opposite sign by

stressing a photoelastic medium. A tunable degree of dispersion compensation is applied by providing an adjustable amount of stress to a photoelastic medium which generates an amount of dispersion sufficient to compensate for the induced dispersion in the optical medium.
(Specification 2-5).

We affirm.

Representative independent claim 1 is illustrative of the invention and it reads as follows:

1. A method comprising:
determining an amount of dispersion in an optical system; and
applying an amount of stress to an optical medium to provide dispersion compensation for the determined amount of dispersion.

The Examiner relies on the following prior art reference to show unpatentability:

Chien	US 2002/0168165 A1	Nov. 14, 2002
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Claims 1-15, all of the appealed claims, stand rejected under 35 U.S.C. § 102(e) as being anticipated by Chien.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief and Answer for the respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Brief have not been considered and are deemed waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUE

Under 35 U.S.C. § 102(e), does Chien have a disclosure which anticipates the invention set forth in claims 1-15?

PRINCIPLES OF LAW

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

ANALYSIS

With respect to the 35 U.S.C. § 102(e) rejection of representative independent claim 1 based on the Chien reference, the Examiner indicates

(Ans. 3) how the various limitations are read on the disclosure of Chien. In particular, the Examiner directs attention to the illustrations in Figures 1, 3, and 4, as well as the accompanying description at paragraphs 50-53 of Chien.

Appellant's arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Chien so as to establish a *prima facie* case of anticipation. Appellant's arguments (Br. 10) focus on the contention that, in contrast to the requirements of the appealed claims, Chien does not determine the amount of dispersion in an optical system and apply the appropriate amount of stress to compensate for the dispersion. According to Appellant (*id.*), Chien simply uses a closed feedback control system to apply a fixed correction signal to the optical system until dispersion is reduced to zero.

After reviewing the disclosure of Chien in light of the arguments of record, however, we are in general agreement with the Examiner's position as stated in the Answer. Our interpretation of the disclosure of Chien coincides with that of the Examiner, i.e., as described at paragraph 52 of Chien, a detector 406 detects the amount of dispersion in the optical system 100 and develops a DC voltage which is provided to processor 402. The processor 402 functions to control the piezoelectric actuators of the compensator 402 to compensate for the determined amount of dispersion. (Chien, paragraph 53).

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Chien, the Examiner's 35 U.S.C. § 102(e) rejection of representative independent claim 1, as well as claims 2-14 not separately argued by Appellant, is sustained.

CONCLUSION

In summary, we have sustained the Examiner's 35 U.S.C. § 102(e) rejection of all the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-15 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

gvw

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